



PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number:
066829-5101 (Formerly Q80401)

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on _____

Signature _____

Typed or printed
Name _____

Application Number:
10/808,465

Filed:
March 25, 2004

First Named Inventor:
Thierry DUPUIS, et al.

Art Unit:
2617

Examiner:
N. T. Huynh

Applicant(s) request(s) review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages are provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
- ☒ attorney or agent of record.
Registration number 47,362
- ☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

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David B. Hardy
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January 29, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 form is submitted.



Response Under 37 C.F.R. § 1.116
Expedited Procedure
Examining Group 2617

PATENT
ATTORNEY DOCKET NO.: 066829-5101 (Formerly Q80401)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Thierry DUPUIS et al.)	Confirmation No.: 6282
)	
Application No.: 10/808,465)	Group Art Unit: 2617
)	
Filed: March 25, 2004)	Examiner: N. T. Huynh
)	
For: METHOD OF UNLOCKING A MOBILE)	Mail Stop AF
TELEPHONE TYPE WIRELESS)	
COMMUNICATION TERMINAL)	

Commissioner for Patents
Customer Window, **Mail Stop AF**
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the final Office Action dated August 28, 2006 and Advisory Action dated December 13, 2006, the period for response extended to January 29, 2007 (January 28, 2007 being a Sunday) with a petition for a two-month extension of time and fee filed herewith, Applicants respectfully request a pre-appeal brief review of the pending rejections. A Notice of Appeal is filed concurrently herewith.

REMARKS

Claims 3-11 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by *Parker*. Applicants respectfully traverse the rejection for at least the following reasons.

Applicants respectfully submit that the Office has not established that *Parker* anticipates each and every feature of Applicants' claimed invention and that all rejections under 35 U.S.C. § 102(b) should be withdrawn. Independent claim 9 recites a method of unlocking a mobile telephone including, in part, the steps of "the user, through said mobile telephone, establishing a communication by using a calling number relating to the manufacturer" and "during this communication, the mobile telephone transmitting to said calling number, an unlocking request using digital data comprising an identification number of the mobile telephone." *Parker* fails to teach or suggest at least these features of claim 9, and hence dependent claims 3-8, 10, and 11.

The Final Office dated August 28, 2006 equates step 106 of *Parker*'s FIG. 4 with the claimed step of "establishing a communication by using a calling number relating to the manufacturer." Paragraph 2 at lines 8-12. FIG. 4 of *Parker* is directed to a method of activating a handset for use in a network. Col. 8, lines 15-19. Prior to its purchase, the handset 20 is locked such that only emergency and activation calls may be established. Col. 8, lines 19-21. In particular, a user inserts a SIM 40 into a handset 20 upon the purchase of the handset 20. Col. 8, lines 21-26. At step 106, the handset 20 sends subscriber identification information when transmitting the number dialed on the handset 20 to a mobile base station 50. Col. 8, lines 29-35. In the proceeding steps, the call is routed to the network's CSC 80 for activation. Col. 8, lines 40-52. *Parker* expressly provides that the CSC 80 is associated with the network operator (i.e., not a manufacturer). Abstract at lines 18-20. In contrast to *Parker*, claim 9 establishes a

communication by using a calling number relating to the manufacturer (i.e., not the network).

As calling a “customer service center” may not be equated with calling a “manufacturer,” *Parker* fails to teach or suggest each and every feature of independent claim 9.

The Advisory Office Action dated December 13, 2006 attempts to overcome these deficiencies in *Parker* by referencing col. 4, lines 35-40, which state:

it is an object of the present invention to provide methods and apparatus to provide a mobile telecommunications handset with a locking mechanism specific to a particular service provider (e.g., operator of multiple networks), a particular network, a particular reseller, or even to an individual.

Relying upon this portion of *Parker*, the Advisory Office Action concludes that “it is inherent that a manufacturer may be included in this listing and also may be interpreted as an individual.”

Item 11, line 7. Applicants respectfully disagree for at least the following reasons.

As clearly described in M.P.E.P. § 2112, the fact that a certain characteristic may (emphasis added) be present is not sufficient to establish inherency of that characteristic. In other words, inherency may not be based on possibilities. Furthermore, the Examiner must provide a basis in fact, or technical reasoning, that the allegedly inherent characteristic necessarily (emphasis added) flows from the teachings of the prior art.

The Advisory Office Action expressly acknowledges that the allegedly inherent features are mere possibilities. The Advisory Office Action states that “a manufacturer may be included in this listing and also may be interpreted as an individual.” Applicants respectfully submit that a manufacturer is not included in this listing. Moreover, the Examiner has failed to provide either a basis in fact or technical reasoning that illustrates that the claimed step of “establishing a communication by using a calling number relating to the manufacturer” necessarily (emphasis

added) flows from the prior art. With regard to the Office's suggestion that a manufacturer may be interpreted as an individual, Applicants note that *Parker* is referring to an individual SIM as stated in col. 3, lines 57-62. Thus, the Examiner's speculation that a manufacturer may be interpreted as an individual is factually incorrect.

As pointed out in M.P.E.P. § 2131, a claim is anticipated by a prior art reference only if each and every element as set forth in the claim is found. Because *Parker* fails to teach or suggest each feature of independent claim 9, the rejection under 35 U.S.C. § 102(b) should be withdrawn. Furthermore, claims 3-8, 10, and 11 depend from independent claims 9. Accordingly, claims 3-8, 10, and 11 are also allowable because of the additional features they recite and the reasons stated above.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the Response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: January 29, 2007

By: _____



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